

Docket No.: 203761US6

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

ATTORNEYS AT LAW

RE: Application Serial No.: 09/606,885

Applicants: Yuji KURODA, et al.

Filing Date: June 29, 2000

For: OPTICAL RECORDING MEDIUM/SYSTEM WITH
HEAT-DISSIPATING AND LIGHT REFLECTING
LAYERS

Group Art Unit: 2653

Examiner: Psitos, A.M.

SIR:

Attached hereto for filing are the following papers:

Request for Reconsideration (with attached copy of Office Action dated 9-28-04)

We have not included a check as we do not believe any fee is required because the Office Action dated September 28, 2004 was issued in error. In the event there are any Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

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DOCKET NO: 203761US6



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
YUJI KURODA, ET AL. : EXAMINER: PSITOS, A.M.
SERIAL NO: 09/606,885 :
FILED: JUNE 29, 2000 : GROUP ART UNIT: 2653
FOR: OPTICAL RECORDING :
MEDIUM/SYSTEM WITH HEAT-
DISSIPATING AND LIGHT REFLECTING
LAYERS

REQUEST FOR RECONSIDERATION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Responsive to the Official Communication of September 28, 2004 (copy enclosed), Applicants traverse all the rejections set forth therein. The undersigned refers to a telephone discussion with Examiner Psitos on January 3, 2005, during which the Examiner agreed that the enclosed outstanding Office Action was improperly issued. Accordingly, Applicants respectfully traverse the rejections in this outstanding Office Action and request that the USPTO issue a new Office Action that corresponds with the above-identified patent application.

As Examiner Psitos agreed that the present outstanding Office Action was issued in error, it is respectfully submitted that this Communication is fully responsive to the outstanding Office Action. Therefore, the undersigned also believes that no extension fees are necessary in light of the above-noted discussion.

Additionally, an attempt was made to contact Examiner Psitos on December 28, 2004 and the undersigned left a message for Examiner Psitos to contact him. Should there be any question regarding the adequacy of the presently filed response, Applicants respectfully request that the Examiner contact the undersigned at 703-412-6489 so that the matter may be quickly resolved.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

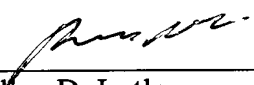
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(OSMMN 06/04)



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DOCUMENT6



JAN 03 2005

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,885	06/29/2000	Yuji Kuroda	09/18850 203761US6	7213
22850	7590	09/28/2004	EXAMINER	
PSITOS, ARISTOTELIS M				
ART UNIT			PAPER NUMBER	
2653				

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Drugs One

RECEIVED: 10-8-04
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: (NX) 10-8-04
Type of Resp(s): (RD) DRUGS
Due Date(s): 12-28-04

Office Action Summary

JAN 03 2005

Application No.

09/606,885

Applicant(s)

KURODA ET AL.

Examiner

Aristotelis M Psitos

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 13-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-12 & 22-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Applicant's communication of 8/13/04 has been received and entered into the file. The request for a new office action due to the un-entered preliminary amendment of 6/10/04 is persuasive. The previous OA, of 7/13/04 is hereby WITHDRAWN, the preliminary amendment of 6/10/04 has been entered and a NEW OFFICE ACTION as set forth below is made. The 892 form is not being resent, since the documents relied upon in the below action are so listed.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

Figures 1-9 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Applicant's election with traverse of Group II in the reply filed on 4/2/04 is acknowledged. The traversal is on the ground(s) that the examiner has failed to comply with MPEP§802.01 in that the examiner has failed to provide appropriate support for BOTH INDEPENDENT AND DISTINCT as so required. This is not found persuasive because such is not the requirement of the above noted MPEP section, rather it is either independent or distinct and since the examiner has, as acknowledged by applicant, provided support for distinct the requirement has been established.

The requirement is still deemed proper and is therefore made FINAL.

The previous requirement is further amended to include newly introduced claims 22-27 to Group II as further elaborated upon by applicant.

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Claims 1-3,13-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/2/04.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 4-10,22-24,26, 28,29,30 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim.

With respect to claims 4 and 22 and 28 (methods) the disclosure of Kim, starting at col. 2 line 21 to col. 7 line 11, and especially the description of figure 6 meet the steps so recited as interpreted by the examiner.

As noted therein, the manufacturing information is read, a test-recording procedure is established, and subsequently recording is performed for the optimum recording power and write strategy. The examiner interprets the phrase "write strategy" as found in claim 28 to mean the proper recording power in order to write upon the disc.

With respect to claim 5, the phrase "recording environment" as interpreted by the examiner is met when the varying recording powers are established.

With respect to claims 6 and 30, note the varying speeds indicated in tables 1 and 2.

With respect to claim 7, the optimum recording power meets such limitations.

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With respect to claim 8, in the toc, information is provided indicative of the manufacturer, which meets this claim.

With respect to claims 9,23 and 29, note the description of the prior art with respect to figure 4b.

With respect to claim 10, see figures 4a and 4b and the description thereof.

With respect to claim 24 note the passage starting at col. 2line 21.

With respect to claims 26 and 33, the sync code is present in the atip data, which is appropriately provided for (inherently) by the acknowledged prior art (in figures 2-4 of Kim).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 11, 31 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 28 above, and further in view of Shaath.

As interpreted by the examiner, the ability of recording information with respect to the apparatus used to record data upon the medium – is taught by the Shaath reference with respect to identification of the drive.

It would have been obvious to modify the base system of Kim with the above additional teaching from Shaath motivation is to provide for further identification of system parameters for subsequent system checks, verification, etc. as taught by Shaath.

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6. Claims 12 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 11 and 22 respectively above, and further in view of Miyata.

The ability of recording appropriate information a number of times (hence an allowable number of times of claim 12) is taught by the Miyata reference – see the abstract.

It would have been obvious to modify the base system of references as relied upon above with respect to claims 11 and 22 and modify such with the additional teaching from Miyata, motivation is as recognized by Miyata to provide for each data recording area of the record medium.

7. Claims 27, 32 and 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 22, 28 and 31 above, and further in view of the acknowledged prior art with respect to figures 9 of applicant's disclosure. Proper identification of such prior art is respectfully requested to ensure a complete search.

The examiner interprets the classification data as defined by this claim to be meet by the information provided in table 9.

It would have been obvious to modify the base system of Kim (with respect to claim 27 and 35) and modify the above combined system of Kim and Shaath (with respect to claim 31) both with the additional teaching form the acknowledged prior art, motivation is to provide for additional data relied upon for system performance and hence increase the robustness of Kim accordingly.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bakx – see the description of figures 1-6 with respect to multiple recordings of test data onto appropriate area (lead in) in this environment.

Kono – see description of figure 13.

Nakajo – see description of table 1 in col. 6.

Osakabe – see description of figures 9-10 test signal recording.

Takahashi – see description of figures 4-6 – test recording, optimum power setting.

Ogawa et al – see col. 12, lines 12-16 wrt drive and recording conditions.

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Yamagami et al – see description of figures 3 and 4 with respect to manufacturing information and book type.

Takeshita – see the description of frame recording of control/condition ability.

Kando et al – abstract with respect to control of average recording power.

Hard copies of the application files are now separated from this examining corps; hence the examiner can answer no questions that require a review of the file without sufficient lead-time.

Any inquiries concerning missing papers/references, etc. must be directed to Group 2600 Customer Services at (703) 306-0377.

Any inquiry concerning the merits of this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
Art Unit 2653



AMP